REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-11 are presently active in this case. The present Amendment amends Claims 1, 5 and 7-8, and adds new Claims 9-11 without introducing any new matter.

The outstanding Office Action objected to the Title as not be descriptive. Claims 1, 3, 5 and 7-8 were rejected under 35 U.S.C. §102(b) as anticipated by Suzuki et al. (U.S. Patent No. 5,699,474; herein "Suzuki"). Claims 2 and 4-6 were rejected under 35 U.S.C. §103(a) as unpatentable over Suzuki in view of Eerenberg et al. (U.S. Patent No. 6,621,979; herein "Eerenberg").

In response to the objection to the Title, the Title has been amended to recite "Transmission Apparatus for Converting a Coded Bit Stream of Images, Transmission System, and Transmission Method Thereof." The change finds non-limiting support in Applicants' specification as originally filed, for example in original Claims 1 and 7-8.

To correct minor formalities and to better comply with U.S. claim drafting practice, Claims 1, 5 and 7-8 are amended. Since these changes are merely formal in nature, they are not believed to raise any questions on new matter.

In response to the rejections of Claims 1-8 under 35 U.S.C. §§102(b) and 103(a), Applicants respectfully request reconsideration of these rejections and traverse the rejections, as discussed next.

Briefly recapitulating, Claim 1 relates to a transmitting apparatus for converting a coded bit stream into a trick play output and sending the coded bit stream to a transmission path. The transmission apparatus includes, *inter alia*: accumulating means for accumulating the coded bit stream including an intra-frame coded picture, a forward predictive-coded picture, and a bidirectionally predictive-coded picture; output control means for controlling

an output of the coded bit stream in an output mode corresponding to a designated trick play operation; picture forming means for forming a picture obtained by copying a predetermined picture; and output means for outputting a picture whose control data has been rewritten and said formed picture in accordance with the control of said output control means.

As explained in Applicants' specification at page 2, lines 21-25, Claim 1 improves upon background transmitting apparatuses, since a stream of a trick play can be outputted in a form such that it can be reproduced by an existing decoder.

Turning now to the applied references, Suzuki describes a recording unit 103 that reproduces and outputs predetermined data in accordance with a high-speed reproduction control signal.[1] Suzuki further explains that an original picture is decoded by the IDCT circuit 404, and that this original picture is stored into field memories 411-414.[2] In a next step, Suzuki's system uses the selector 406 to select a picture form the field memories 411-414 that has to be outputted. However, Suzuki fails to teach or suggest a picture forming means for forming a picture obtained by copying a predetermined picture. As further explained in Suzuki at column 15, lines 12-28, Suzuki states that "data of B portion of I picture in the figure is read out and decoded, and only portion of intra-data of frame displayed at time earlier by one frame is then changed."[3] Accordingly, Suzuki cannot read out the entire I-picture, since "[i]n the case where read-out speed of reproducing section 81 is not sufficient, it is unable to read out all data of I pictures at the time of high speed reproduction."[4] In other words, Suzuki only copies a portion B of the I-image and then adds the image data portions A and C since no data is available there.[5] Accordingly, copying a portion of a picture and adding image data portions to the remaining portions of an image, as

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[1] See Suzuki in the Abstract and in Figure 1.
[2] See Suzuki at column 12, lines 56-59 and in corresponding Figure 2.
[3] See Suzuki at column 15, lines 13-15 and in Figure 10.
[4] See Suzuki at column 15, lines 5-11.
[5] See Suzuki at column 15, lines 37-45 and in Figures 10-11.

described in <u>Suzuki</u>, *is not* picture forming means for forming a picture obtained by copying

a predetermined picture, as recited in Applicants' Claim 1.

The reference <u>Eerenberg</u> does not remedy the deficiencies of <u>Suzuki</u>, since <u>Eerenberg</u>

also does not teach or suggest picture forming means for forming a picture obtained by

copying a predetermined picture. <u>Eerenberg</u> explains that an I-frame is retrieved from an I-

frame included in the original normal play information stream. However, <u>Eerenberg</u> fails to

teach or suggest a picture forming means for forming a picture obtained by copying a

predetermined picture, as recited in Applicants' Claim 1. Since <u>Suzuki</u> clearly explains that

his system is not able to read out all the data of an I-picture, as explained above, it is believed

that the combination of <u>Suzuki</u> with <u>Eerenberg</u> is improper and not obvious, since such

combination would require substantial reconstruction of the elements of <u>Suzuki</u>'s data

reproduction system.

Therefore, even if the combination of <u>Suzuki</u> and <u>Eerenberg</u> is assumed to be proper,

the combination fails to teach every element of the claimed invention. Specifically, the

combination fails to teach the claimed picture forming means. Accordingly, Applicants

respectfully traverse, and request reconsideration of, this rejection based on <u>Suzuki</u> and

<u>Eerenberg</u>.[6]

Independent Claims 7-8 recite features analogous to the features recited in

independent Claim 1. Accordingly, for the reasons stated above for the patentability of Claim

1, Applicants respectfully submit that the rejections of Claims 7-8 are also believed to be

overcome in view of the arguments regarding independent Claim 1

To vary the scope of protection recited in the claims, new Claims 9-11 are added.

New Claims 9-11 depend upon independent Claims 1, 7-8, respectively, and recite features

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[6] See MPEP 2142 stating, as one of the three "basic criteria [that] <u>must</u> be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest <u>all</u> the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."
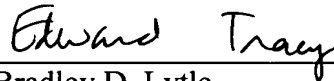
regarding the representation of an entire frame of the coded bit stream. New Claims 9-11

find non-limiting support in the disclosure as originally filed, for example at page 18, lines 4-

17, page 19, lines 7-24, with corresponding Figure 11. Therefore, the changes to the claims

are not believed to raise a question of new matter.[7]

Consequently, in view of the present amendment, no further issues are believed to be

outstanding in the present application, and the present application is believed to be in

condition for formal Allowance. A Notice of Allowance for Claims 1-11 is earnestly

solicited.

Should the Examiner deem that any further action is necessary to place this

application in even better form for allowance, the Examiner is encouraged to contact

Applicants' undersigned representative at the below listed telephone number.

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[7] See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."